

10/815,047

01AN170-A

REMARKS

Claims 1-31 are currently pending in the subject application and are presently under consideration. Amendments to the specification are found at page 2. A version of all pending claims is found at pages 3-6. Claims 1, 12 and 23 have been amended herein and are believed to be in condition for allowance. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection of Claim 1

Claim 1 stands objected to because of insufficient antecedent basis for "the length" in lines 5 and 6. This objection is now believed to be moot and should be withdrawn in view of the amendment to claim 1.

II. Rejection of Claims 23-31 Under 35 U.S.C §112

Claims 23-31 stand rejected under 35 U.S.C §112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. In view of the amendments to independent claim 23, it is believed that this rejection to the subject claims should be withdrawn.

III. Rejection of Claims 1-7 and 10-19 Under 35 U.S.C. §102(b)

Claims 1-7 and 10-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Weingartner (US 4,462,467). Applicant's representative respectfully requests that this rejection be withdrawn for at least the following reasons. Weingartner does not disclose each and every limitation set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes **each and every limitation** set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

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Applicant's claimed invention relates to motors, and more particularly, to a linear and/or rotary system operative to control operation of an associated tool. Independent claims 1 and 12 recite similar limitations, namely *a moveable member that moves in a rotary motion about a central axis and a linear motion along the central axis to position an associated drive member*. Weingartner is silent regarding such a novel aspect of the subject claims.

More particularly, the invention as claimed employs a moveable member to position an associated drive member for operation of an attached tool to mitigate the risk of an imprecise task being carried out by the tool. Weingartner fails to teach or suggest such a feature of the claimed invention.

Weingartner relates to a percussion drilling machine comprising a drill shaft with a chuck arranged to hold a drilling tool. Electromotors are used to power both a percussive device and a driving element that both act upon the drilling tool. In the Office Action, the Examiner attempts to equivocate the free piston taught by the cited reference with the moveable member as disclosed in the claimed invention. The free piston is directed towards interacting with a percussion piston to aid in *driving* the drilling tool. Therefore, the free piston does not act as a positioning device for the percussion piston. Moreover, Weingartner is silent regarding any type of moveable member that moves in a rotary motion about a central axis and a linear motion along the central axis for positioning a drive member for operation of an associated tool. Consequently, improved accuracy with respect to the operation of a tool is not accomplished by the cited reference.

In view of at least the foregoing, it is readily apparent that Weingartner does not teach the identical invention in as complete detail as is contained in the subject claims. Accordingly, this rejection with respect to independent claims 1 and 12 (and the claims that depend therefrom), should be withdrawn.

IV. Rejection of Claims 8, 9 and 20-22 Under 35 U.S.C. §103(a)

Claims 8, 9 and 20-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weingartner in view of Riello *et al.* (US 6,216,798). Withdrawal of this rejection is requested for at least the following reasons. The cited references, neither alone nor in combination, teach or suggest all limitations set forth in the subject claims.

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Claims 8 and 9 depend from independent claim 1 and claims 20-22 depend from independent claim 12. As discussed *supra*, Weingartner fails to disclose a moveable member that moves in a rotary motion about a central axis and a linear motion along the central axis to position an associated drive member. Riello *et al.* fails to compensate for the deficiencies of Weingartner. Riello *et al.* concerns work units for automatic machine tools in which a spindle moves in translation and rotates with respect to a work axis for operation of an associated tool. However, Riello *et al.* does not employ a device (such as the moveable member taught in the claimed invention) for positioning the spindle for accurate operation of the tool. Accordingly, it is respectfully requested that this rejection to claims 8, 9, and 20-22 be withdrawn.

10/815,04701AN170-AConclusion

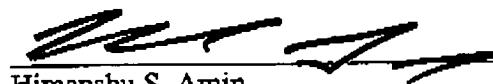
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ALBR241USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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